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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/298,889	04/26/1999	RAVI GANESAN	33500-030	2552

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EXAMINER

GORT, ELAINE L

ART UNIT	PAPER NUMBER
3627	

DATE MAILED: 05/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/298,889	GANESAN, RAVI
	Examiner	Art Unit
	Elaine Gort	3627

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 12 February 2002.

2a) This action is **FINAL**.      2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 1-24 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 1-24 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

    If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) All b) Some \* c) None of:

        1. Certified copies of the priority documents have been received.

        2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

        3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    \* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

    a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6.

4) Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.

5) Notice of Informal Patent Application (PTO-152)

6) Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-6, 12, 13 and 21 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. It is unclear in claim 1, line 16 of claim 1 what is meant by "the transfer of funds". For purposes of this action and the prior office action Examiner construes this to refer to "a directive to transfer funds" as recited in claim 1, line 10 and that no actual transfer of funds is being claimed.

It is further unclear in claims 3 and 4 if the step of "transmitting the directive" is being positively recited and claimed as there is no antecedent basis for the transmission of a directive, only the limitation that the transmission be after or before receipt of an access request. Claim 2 only refers to the transmission of "stored remittance information".

Claim 12 recites the limitation "the memory" in line 6. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

3. Claims 1-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Chang et al. (US Patent 5,884,288).

Chang et al. discloses a system, network and article of manufacture capable of carrying out a method for electronically paying bills using a plurality of network stations (202 and 208), each representing a different one of a plurality of users including payers and payees, the payers and payees having associated payment accounts and deposit accounts maintained at a plurality of financial institutions (206, see also column 5, lines 10+), comprising the steps of:

Receiving, at a central station (includes the Internet, 202, 208 and 206), a first instruction (806) from a first of the plurality of user stations (804, instruction for payor to pay bill, figure 8B) representing a first of the payers, to make payment of a first bill (see figure 8B) of a first of the payees;

Generating in accordance with the received first instruction, a directive to transfer funds (directive made when payment instruction (806) is entered by payor) from a first of the payment accounts which is associated with the first payer and maintained at a first of the plurality of financial institutes (206), to a first of the deposit accounts which is

associated with the first payee and maintained at a second of the plurality of financial institutions;

Generating remittance information associated with payment of the first bill (remittance information includes Payee name, Due Date, and Amount Due which are generated by payee, see figure 8B, generated when payee accesses payor's account and creates bill);

Storing the remittance information in a central database (central database includes all data storage of the central station defined previously as the Internet, 202, 208 and 206, remittance information is stored with the bill at the payor's bank presumably in the bill payment database (250) and is also stored in the payee's accounting records disclosed in column 7, line 9+ and line 37+ which would be accessible to the payee. These customer accounts inherently may be accessible via a payee network system with the customer/payor database accessible over the internet) so as to be accessible to a second of the plurality of user stations representing the first payee;

Receiving, at the central station (includes both the Internet, 202, 208 and 206), a request, from the second user station, to access the stored remittance information (occurs when payee creates the bill and remittance information and/or when payee updates account information when a payment is made. This step and the following step is carried out when the remittance information is created for the next months bill via payee on the payee's station prior to sending out the bill to payor);

Transmitting, responsive to the receipt for the access request, the stored remittance information to the second user station (occurs when payee on station receives the remittance information from the database to be used to submit bill to payor or to update account with payment);

The transmission of the directive to pay occurs only after receiving the access request (directive to pay can only occur after payee has submitted electronic bill to payor which is created based on information received when the bill was created);

The transmission of the directive to pay occurs before receiving the access request (directive to pay occurs before account is updated to ensure payment was actually made, also the prior months directive to pay occurs prior to the receipt of an access request for account information for the following months bill to the same payor, i.e. reoccurring monthly statements);

Processor/communications network (includes all processing carried out by the Internet, 202, 208 and 206) configured to carry out the above steps;

Central database (includes all databases associated with the processor, for example payees' accounting records including payors' account information which includes remittance information which is accessible to payee);

A communications network station (Internet and all associated payee's internal Intranet/network system);

A first plurality of network stations (payor's stations, 202);

A central network station connected to the communications network (includes all billers'/payees' company customer account files stored on internal company computer

network systems accessible within the companies via individual employee P.C.s; which receives requests for, retrieves and transmits requested remittance information when bills are created by a payee employee to present a bill to a payor);

A second plurality of network stations (includes all billers'/payees' individual employee P.C.s that have access to the internal company accounting files);

A computer readable storage media (includes all storage media carried out by the Internet, 202, 208 and 206); and

Computer programming stored on the storage media causing operation (includes all computer programming carried out by the Internet, 202, 208 and 206 configured to carry out the above method steps).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

In the alternative, claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chang et al.

Chang et al. discloses the claimed invention but is silent regarding the structure of the companies performing the billing, such as the number of user stations each payee has, how customer accounts are stored and accessed, and how they are

configured. The use of internal network systems within a company which includes networked P.C.s and servers containing accounting data providing access to accounting and payment records on a company server via either and Intranet or the Internet is old and well known in the art of networking to allow multiple users with the ability to perform the same activities such as update accounting records. The use of more than one deposit account is old and well known in the art of accounting to track income relating to different internal businesses or operations carried out by the same company. An example of this is the tracking of income from services and income from products which generally require independent accounting due to differing tax implications along with the desire of companies to understand the differences in the two internal businesses. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the bill payment system of Chang et al. with payee companies employing internally networked stations with a company server accessible thru the Internet or Intranet and utilizing various deposit accounts, in order to allow more than one employee to perform the same activities and track incomes from different income streams.

#### ***Response to Arguments***

Applicant's arguments filed 2/12/02 have been fully considered but they are not persuasive. See detailed discussion of Examiner's interpretation of the claims in relation to Chang et al. above.

Examiner notes that order of the method steps is not specified in the claims other than in regard to claims indicating the timing of when the directive is transmitted in relation to the receipt for the access request (for example claim 3 and claim 4).

Areas of patentability may exist relating to the following areas:

- further defining remittance information;
- further defining the directive to transfer of funds;
- claiming an actual transfer of funds; and
- more specifically defining the location of the stored remittance information.

Examiner invites Applicant to request an in-person interview to discuss the above mentioned areas of patentability, if they feel it may be of assistance.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Schutzer (US Patent 6,292,789) discloses a method and system for bill presentment and payment with remittance information storage and retrieval.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Elaine Gort whose telephone number is (703)308-6391. The examiner can normally be reached on Monday through Thursday from 7:00 am to 5:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703)308-5183. The fax phone number for the organization where this application or processing is assigned is (703)872-9327.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.

EG



May 3, 2002



DOUGLAS HESS  
PRIMARY EXAMINER

5-6-02